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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,150	02/05/2001	Fumio Nagumo	450108-02376	2773
20999 7590 05/03/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER HOYE, MICHAEL W	
			ART UNIT .2623	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/700,150

Applicant(s)

NAGUMO, FUMIO

Examiner

Michael W. Hoyer

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 16, 2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed February 16, 2007 have been fully considered but they are not persuasive.

Regarding amended independent claim 17, the Applicant argues on page 9 that, "Zigmond does not teach or suggest an information receiving device, comprising condition setting means for the viewer to set display conditions for the commercial information wherein said display conditions include an option to not display any commercial information such that only program information is displayed, as recited in independent claim 17."

In response, the Examiner respectfully disagrees with the Applicant because Zigmond clearly teaches the newly amended claim language, as stated above, where in col. 14, lines 24-34 Zigmond discloses that, "the ad selection criteria may be set or modified by the viewer in order to request or block advertisements for selected classes of goods or services...In an extreme case,

Art Unit: 2623

the ad selection criteria 83 may be modified in response to, for example, increased subscription fees from the viewer in order to allow the viewer to forego advertisements altogether...”

Regarding amended independent claim 24, the Applicant argues on page 9 that, “For reasons similar to, or somewhat similar to, those described above with regard to independent claim 17, independent claim 24 is also believed to be patentable.”

In response, the Examiner respectfully disagrees with the Applicant for similar reasons as presented above for claim 17.

### ***Drawings***

3. The drawings are objected to because in Fig. 1 the arrow from combiner 26 to broadcast contents recording means 23 should be pointing to the combiner 26 not toward the broadcast contents recording means 23. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 2623

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 17-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al (USPN 6,698,020).

Regarding claims 17 and 24, Zigmond discloses an information receiving device and method for receiving separately transmitted program information and commercial information with the program (see fig 4 and fig 5). It is noted that the commercial delivery and program delivery are separate but from the same source i.e. the advertisement content provider is the same as the video programming content provider (see col. 8, lines 17 - 20). Zigmond further discloses transmitting and receiving commercial information and program information over a satellite communication channel or 'first channel'. Zigmond further discloses "In one implementation, ad source 62 transmits advertisement streams 64 only periodically over satellite 134, in which case, a device such as advertisement repository 86 of FIG. 5 may be used to store the transmitted advertisements for later selection and display" (see col. 17, line 50 - col. 18 line 13). Thus, Zigmond discloses receiving the commercial information before the program information.

Art Unit: 2623

Zigmond further teaches a user can set the rules for displaying a commercial (col. 11, lines 50-54) and thus discloses the claimed 'condition setting means for a viewer to set display conditions for the commercial information'.

It is further noted that the set of rules are inherently formed by control means for forming control data as necessary for controlling commercial insertion (see col. 11, lines 50-54).

Zigmond further discloses a video switch 68 located in ad insertion device 60 (see Fig. 4) for selectively selecting the commercial and program to form a combined output signal for display on display 58.

Zigmond further discloses a transmission means and the user side for transmitting control data to a source company which transmits the program information and the commercial information (see col. 4, lines 55-65, col. 7, lines 57-67, col. 11, lines 48-58, col. 15, lines 2-16).

Zigmond further discloses wherein said control means, at the viewers request, and in response to viewer operation of the condition setting means causes the transmission of commercial related information to be transmitted from a commercial related information memory as met by col. 18, line 38 – col. 19, line 23, where a "cross-over" link may be presented to the viewer, which offers the viewer access to further information relating to the topic or subject that is simultaneously displayed on the video programming of display device 58. More specifically, the additional information may include information relating to the program description, or topics, dialog, persons, brand names, etc., that appear in the video programming feed 52, and the information is transmitted from a programming database.

Zigmond further discloses the claimed, "wherein said display conditions include an option to not display any commercial information such that only program information is

Art Unit: 2623

displayed”, as met by col. 14, lines 24-34, where, “the ad selection criteria may be set or modified by the viewer in order to request or block advertisements for selected classes of goods or services...In an extreme case, the ad selection criteria 83 may be modified in response to, for example, increased subscription fees from the viewer in order to allow the viewer to forego advertisements altogether...”

Regarding claims 18 and 25, Zigmond discloses an advertisement repository 86 (Fig. 5) for storing or recording the commercial information.

Regarding claims 19 and 27, Zigmond discloses the advertising rules can be selected by the information provider (see col. 11, lines 50-54) and also discloses the advertisers can target ads (see col. 9, lines 24-38).

Regarding claims 20 and 26, Zigmond discloses charging a fee based on blocking of commercials (see col. 14, lines 25-35).

Regarding claims 21 and 28, Zigmond discloses a user can block all advertisements all together (see col. 14, lines 28-32) thus indicating a ratio of 1 to 0 i.e. programming to advertisements.

Regarding claims 22 and 29, Zigmond discloses charging a fee for blocking commercials and thus discloses the claimed ‘display conditions indicate the commercial information should not be combined with the program information’ (see col. 14, lines 25-35).

Regarding claims 23 and 30, Zigmond discloses the claimed ‘display conditions indicate classifications of the commercial information which should be combined with the program information’ (see ‘certain goods and services’ in col. 14, lines 36-48 and a specify a viewer’s hobbies, interests, spending habits, and anticipated major purchases in col. 10, lines 60-64).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is **571-272-7346**.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at **571-272-7353**.

**Any response to this action should be mailed to:**

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

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Art Unit: 2623

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **571-272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **<http://pair-direct.uspto.gov>**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

April 30, 2007

A handwritten signature in black ink, appearing to read "Michael W. Hoyer". The signature is fluid and cursive, with the first name "Michael" and last name "Hoyer" being the most prominent parts.

Michael W. Hoyer  
Patent Examiner  
Art Unit 2623